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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,356	09/11/2001	Matthias Witschel	49828	4151

7590

01/17/2003

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/936,356

Applicant(s)

WITSCHER ET AL.

Examiner

Rebecca L Anderson

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Due to the numerous variables in the claims, e.g., X, Y, R1, R2, R3, R4, R5, R6, R7, R8, R9, R10, R11, R12, R13, R14, R15, R16, I, etc., and their widely divergent meanings, a precise listing of inventive groups cannot be made. The following groups are exemplary:

**Group I**, claim(s) 1-7 and 14-17 drawn to products of the formula I, wherein: X is O, Y together with the two carbons to which it is attached forms a saturated, partially saturated or unsaturated pyridine, R1, R2, R3, R4, R5, R6, R7, R8 and I are as found in claim 1, R9 is IIa, R10 is halogen, R11 and R12 are as found in claim 1, R13 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated, R14 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated, R15 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated and R16 is as found in claim 1, processes for their preparation and their methods of use.

**Group II**, claim(s) 1-6, 8 and 12-17 drawn to products of the formula I wherein: X is CH<sub>2</sub>, Y together with the two carbons to which it is attached forms a saturated,

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partially saturated or unsaturated pyrazole, R1, R2, R3, R4, R5, R6, R7, R8 and I are as found in claim 1, R9 is IIb, R10 is OR13, R11 and R12 are as found in claim 1, R13 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated, R14 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated, R15 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated and R16 is as found in claim 1, processes for their preparation and their methods of use.

**Group III**, claim(s) 1-6, 9 and 14-17 drawn to products of the formula I wherein: X is S, Y together with the two carbons to which it is attached forms a saturated, partially saturated or unsaturated 1,2-oxazole, R1, R2, R3, R4, R5, R6, R7, R8 and I are as found in claim 1, R9 is IIa, R10 is SR13, R11 and R12 are as found in claim 1, R13 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated, R14 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated, R15 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated and R16 is as found in claim 1, processes for their preparation and their methods of use.

**Group IV**, claim(s) 1-6, 10 and 14-17 drawn to products of the formula I wherein: X is a bond, Y together with the two carbons to which it is attached forms a saturated,

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partially saturated or unsaturated 1,3-thiazole, R1, R2, R3, R4, R5, R6, R7, R8 and I are as found in claim 1, R9 is IIb, R10 is SO<sub>2</sub>R<sub>14</sub>, R11 and R12 are as found in claim 1, R13 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated, R14 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated, R15 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated and R16 is as found in claim 1, processes for their preparation and their methods of use.

**Group V**, claim(s) 1-6, 11 and 14-17 drawn to compounds of the formula I wherein: X is O, Y together with the two carbons to which it is attached forms a saturated, partially saturated or unsaturated pyrazine, R1, R2, R3, R4, R5, R6, R7, R8 and I are as found in claim 1, R9 is IIa, R10 is NR<sub>15</sub>R<sub>16</sub>, R11 and R12 are as found in claim 1, R13 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated, R14 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated, R15 is C1-C6-alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl where the abovementioned alkyl radicals may be partially or fully halogenated and R16 is as found in claim 1, processes for their preparation and their methods of use.

**Group VI**, claim(s) 18 drawn to compounds of the formula VI wherein: X is S, Y together with the two carbons to which it is attached forms a saturated, partially saturated or unsaturated pyridine, R1, R2, R3, R5 and I are as found in claim 1, R4 is as found in claim 18 and R17 is hydroxyl.

**Group VII**, claim(s) 18 drawn to compounds of the formula VI wherein: X is O, Y together with the two carbons to which it is attached forms a saturated, partially saturated or unsaturated pyrazole, R1, R2, R3, R5 and I are as found in claim 1, R4 is as found in claim 18 and R17 is hydroxyl.

**Group VIII**, claim(s) 19 drawn to compounds of the formula IX wherein: X is O, Y together with the two carbons to which it is attached forms a saturated, partially saturated or unsaturated 1,2-oxazole, R1, R2, R3 and I are as found in claim 1, R4 and R5 are as found in claim 19 and L4 is as found in claim 19.

**Group IX**, claim(s) 19 drawn to compounds of the formula IX wherein: X is S, Y together with the two carbons to which it is attached forms a saturated, partially saturated or unsaturated 1,3-thiazole, R1, R2, R3 and I are as found in claim 1, R4 and R5 are as found in claim 19 and L4 is as found in claim 19.

**Group X**, claim(s) 20 drawn to aniline compounds of the formula XV wherein: X is CH<sub>2</sub>, Y together with the two carbons to which it is attached forms a saturated, partially saturated or unsaturated pyrazine, R1, R2, R3, R5 and I are as found in claim 1 and R4 is as found in claim 20.

**Group XI**, claim(s) 20 drawn to aniline compounds of the formula XV wherein: X is a bond, Y together with the two carbons to which it is attached forms a saturated,

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partially saturated or unsaturated pyridine, R1, R2, R3, R5 and I are as found in claim 1 and R4 is as found in claim 20.

**Group XII**, claim(s) 21 drawn to nitrile compounds of the formula XVI wherein: X is O, Y together with the two carbons to which it is attached forms a saturated, partially saturated or unsaturated pyridine, R1, R2, R3 and I are as found in claim 1 and R4 and R5 are as found in claim 21.

**Group XIII**, claim(s) 21 drawn to nitrile compounds of the formula XVI wherein: X is S, Y together with the two carbons to which it is attached forms a saturated, partially saturated or unsaturated pyrazole, R1, R2, R3 and I are as found in claim 1 and R4 and R5 are as found in claim 21.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhausted as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same. The applicant may also choose to elect a single disclosed species and the examiner will endeavor to create a group comprising the elected species.

The claims herein lack unity of invention under PCT rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain a tricyclic compound characterized in that the respective benzoyl unit

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that is contained is fused via positions 3 and 4 with a bicycle, which does not define a contribution over the prior art (as can be seen by WO 97/19087 and EP-A 860 441). The substituents on the tricyclic compound and the bicycle itself vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.

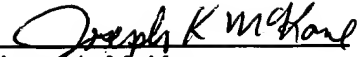


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